

ESTTA Tracking number: **ESTTA651181**

Filing date: **01/21/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212950
Party	Plaintiff McDonald's Corporation
Correspondence Address	JOHN A CULLIS REED SMITH LLP 10 SOUTH WACKER DRIVE, 40TH FLOOR CHICAGO, IL 60606 UNITED STATES ipdocket-chi@reedsmith.com, rbrowne@reedsmith.com, jcullis@reedsmith.com, ljames@reedsmith.com, jbeifuss@reedsmith.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Lawrence E. James, Jr.
Filer's e-mail	ipdocket-chi@reedsmith.com, rbrowne@reedsmith.com, ljames@reedsmith.com, jcullis@reedsmith.com, jnewman@reedsmith.com, mbenson@reedsmith.com
Signature	/Lawrence E. James, Jr./
Date	01/21/2015
Attachments	Motion for Leave to File an Amended Notice of Opposition w Amended Notice of Opp.pdf(52224 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial Nos.:

79/111,190 for McFIT

79/129,412 for McFIT (& Design)

79,129,414 for McFIT (& Design)

Published in the Official Gazette
on May 14, 2013, March 4, 2014 and
March 11, 2014, respectively.

McDONALD’S CORPORATION,

Opposer,

v.

McFIT GMBH,

Applicant.

Opposition No. 91212950
(parent)

Opposition No. 91215647

**MOTION FOR LEAVE TO FILE AN AMENDED NOTICE OF OPPOSITION AND
REQUEST FOR SUSPENSION PENDING DISPOSITION OF MOTION**

Pursuant to Trademark Rule 2.107 and Federal Rule of Civil Procedure 15(a), Opposer, McDonald’s Corporation (“McDonald’s”), moves to amend the Notices of Opposition filed in Opposition Nos. 91215657 and 91212950, which the Board consolidated May 5, 2014. More specifically, Opposer moves to add an additional ground for opposition that was established during the course of discovery, namely, that Applicant lacked a bona fide intent to use the above-captioned trademarks (the “McFIT Marks”) when it filed the respective trademark applications. A copy of McDonald’s Amended Notice of Opposition is attached as Exhibit A.

MEMORANDUM IN SUPPORT OF MOTION

I. Introduction

On or about December 23, 2011 and March 15, 2013, Applicant filed Application Serial Nos. 79/111,190, 79/129,412 and 79/129,414 for the McFIT Marks pursuant to Section 66(a) of the U.S. Trademark Act. On information and belief, in connection with each of these applications, and pursuant to 15 U.S.C. § 1141f(a), Applicant submitted a declaration stating that it had a bona fide intent to use the McFIT Marks “in commerce that can be controlled by the United States Congress.” On May 14, 2013, March 4, 2014 and March 11, 2014, the McFIT Marks were published in the Official Gazette. McDonald’s timely filed Notices of Opposition on October 10, 2013, and March 28, 2014. In its notices, McDonald’s alleged that Applicant’s proposed use of the McFIT Marks would be likely to cause confusion with, and would diminish and dilute the distinctive quality of, McDonald’s famous “Mc” formative family of marks. As representative of that family, McDonald’s asserted nineteen of its registrations for different “Mc” formative marks. On December 19, 2013, and May 6, 2014, Applicant answered McDonald’s Notices of Opposition, including five affirmative defenses. On November 3, 2014, Applicant propounded its responses to McDonald’s First Set of Interrogatories and First Set of Requests for Production. Discovery is set to close on March 3, 2015.

II. Applicant Lacks a Bona Fide Intent to Use the McFIT Marks

As a result of discovery in this consolidated Opposition, it has become clear that Applicant lacked a bona fide intent to use the McFIT Marks in connection with any of the goods or services identified in the applications at the time they were filed. In response to McDonald’s interrogatories and document requests requesting that Applicant identify certain information and documents relating to its intended use of the McFIT Marks in the United States, Applicant did

not identify any such information, documents or activities. To the contrary, Applicant admitted that it has not determined: (1) what goods or services will be offered in connection with the McFIT Marks in the United States (Request for Production No. 4); (2) any date on which it intends to use the McFIT Marks in commerce (Request for Production No. 6); (3) any marketing plans for products or services sold or intended to be sold under the McFIT Marks within the United States (Request for Production No. 9); (4) the geographic areas or channels of trade within the United States in which Applicant's goods or services will be advertised and/or promoted under the McFIT Marks (Request for Production Nos. 12 and 14); or (5) the manner or media in which Applicant's goods or services will be advertised and/or promoted under the McFIT Marks within the United State (Interrogatory Nos. 9 and 10). *See* Applicant's Responses to Opposer's First Set of Interrogatories, ¶¶ 9-10, attached hereto as Exhibit 1; Applicant's Responses to Opposer's First Set of Requests for Production of Documents and Things, ¶¶ 4, 6, 9, 12, and 14, attached hereto as Exhibit 2. Moreover, Applicant concedes that it has not undertaken any advertising and/or promotion of any products or services under the McFIT Marks in the United States, or even determined the market for its products and services. *See* Applicant's Responses to Opposer's First Set of Request for Production of Documents and Things, ¶¶ 10, 13; *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1507 (TTAB 1993) (noting that the lack of documentary evidence on the part of an applicant regarding its intent to use an applied-for mark is sufficient to establish a prima facie case of lack of bona fide intent).

In fact, the only activities Applicant identifies—its use of the McFIT Marks in Europe and its alleged past collaboration with McDonald's (in Europe) in connection with McDonald's "Monopoly" game sweepstakes—are irrelevant. *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha et al.*, 225 U.S.P.Q. 540, 546 (5th Cir. 1985) (noting that "foreign use is

ineffectual to create trademark rights in the United States” and that it is error to admit evidence of the parties' foreign trademark practices in U.S. proceedings); *see also E. Remy Martin Martin & Co. v. Shaw-Ross Int'l Imports, Inc.*, 756 F.2d 1525, 1531 (11th Cir. 1985) (finding that the district court erred in considering the status of the parties' marks in France; “Our concern must be the business and goodwill attached to United States trademarks, not French trademark rights under French law.”).

Accordingly, McDonald's hereby seeks leave to amend its Notices of Opposition to add as a ground for relief that Applicant lacked the requisite bona fide intent to use the McFIT Marks in commerce at the time applications were filed.

III. McDonald's Amended Notice of Opposition is Legally Sufficient

Trademark Rule 2.107 and Rule 15(a) of the Federal Rules of Civil Procedure provide that “[t]he court should freely give leave [to amend] when justice so requires.” Fed R. Civ. P. 15(a). *Froman v. Davis*, 371 U.S. 178, 182 (1962) (“If the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he ought to be afforded an opportunity to test his claims on the merits.”). “Amendments to pleadings should be allowed with great liberality at any stage of the proceeding . . . unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.” *Commodore Elecs. Ltd.*, 26 U.S.P.Q.2d at 1505. Accordingly, when deciding to grant an opposer's motion for leave to amend, the Board must consider whether there is any undue prejudice to the applicant and whether the amendment is legally sufficient. *Id.* To be legally sufficient, the amendment need only allege facts that, if true, would establish an opposer's standing. *Id.* at 1506 (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 124 (C.C.P.A. 1982)).

Any party that believes it would be damaged by registration of a mark may oppose that mark's registration. 15 U.S.C. § 1063. To have standing to oppose, a party need only have a real interest in the outcome of the proceeding and a reasonable basis for its belief in damage. TMBP § 303.03 (citing *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999)). McDonald's amended pleading establishes its standing to challenge Applicant's right to registration based upon the following facts where are set forth more fully in McDonald's amended pleading: (i) McDonald's belief that it will be damaged by the registration, (ii) its efforts to promote and protect its marks, including its famous "Mc" formative family of marks, (iii) its rights in those marks including federal registrations; and (iv) its assertion that Applicant's marks are confusingly similar to, and will diminish and dilute the distinctive quality of, McDonald's marks. Furthermore, it is well established that a lack of bona fide intent to use is a valid ground for opposing a trademark application. *Commodore Elecs. Ltd.*, 26 U.S.P.Q.2d at 1507. Accordingly, McDonald's amended pleading is legally sufficient because it alleges facts that establish both its standing to challenge Applicant's right to registration and further statutory grounds for opposing the Applicant's applications for the McFIT Marks.

IV. McDonald's Amendment Will Not Prejudice Applicant

The present motion will not prejudice Applicant because the discovery period is not set to close until March 3, 2015. Furthermore, any information or documents (if any exist) relevant to the issue of lack of bona fide intent is already in the possession of Applicant. McDonald's filed this motion in a timely manner after becoming aware during the discovery period of Applicant's lack of bona fide intent to use the McFIT Marks in the United States.

V. Request for Suspension Pending Disposition of this Motion

In order to permit Opposer to complete discovery on all bases for this opposition, including the new lack of bona fide intent basis, prior to the close of discovery, Opposer requests that discovery be suspended pending the outcome of this motion. Opposer anticipates taking depositions of Applicant. In the interest of minimizing the burden and expense on all parties, it would be preferable to complete such depositions after the Board has ruled on the pending Motion, so that Opposer can address all grounds in a single deposition of each witness. Accordingly, Opposer hereby requests suspension of discovery pending the disposition of this motion.

V. Conclusion

WHEREFORE, because McDonald's Amendment is timely filed, legally sufficient, and will not prejudice Applicant, McDonald's respectfully requests that the Board enter an Order pursuant to TBMP § 57 and Fed. R. Civ. P. 15(a) granting its Motion for Leave to File an Amended Notice of Opposition, attached hereto, and adjusting the trial dates as the Board deems appropriate.

Respectfully submitted,

McDONALD'S CORPORATION

Date: January 21, 2015

By: /Lawrence E. James, Jr./

Robert E. Browne
John A. Cullis
Lawrence E. James, Jr.
REED SMITH LLP
10 South Wacker Drive, 40th Floor
Chicago, IL 60606-7507
(312) 207-1000 Telephone
(312) 207-6400 Facsimile

CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing **MOTION FOR LEAVE TO FILE AN AMENDED NOTICE OF OPPOSITION** is being electronically transmitted via the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/> on the date noted below:

Date: January 21, 2015

By: /Lawrence E. James, Jr./
One of the Attorneys for Opposer,
McDonald’s Corporation

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **MOTION FOR LEAVE TO FILE AN AMENDED NOTICE OF OPPOSITION** upon Applicant’s counsel:

Stacey C. Friends, Esq.
Ruberto, Israel & Weiner, PC
255 State St., 7th Floor
Boston, Massachusetts 02109

via First Class U.S. Mail on January 21, 2015:

/Lawrence E. James, Jr./
One of the Attorneys for Opposer,
McDonald’s Corporation

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial Nos.:

79/111,190 for McFIT

79/129,412 for McFIT (& Design)

79/129,414 for McFIT (& Design)

Published in the Official Gazette
on May 14, 2013, March 4, 2014 and
March 11, 2014, respectively.

McDONALD'S CORPORATION,

Opposer,

v.

McFIT GMBH,

Applicant.

Opposition No. 91212950
(parent)

Opposition No. 91215647

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial Nos.:

79/111,190 for McFIT

79/129,412 for McFIT (& Design)

79/129,414 for McFIT (& Design)

Opposition No. 91212950
(parent)

Opposition No. 91215647

Published in the Official Gazette
on May 14, 2013, March 4, 2014 and
March 11, 2014, respectively.

McDONALD'S CORPORATION,

Opposer,

v.

McFIT GMBH,

Applicant.

AMENDED NOTICE OF OPPOSITION

Opposer, McDonald's Corporation, a corporation organized and existing under the laws of the State of Delaware, with offices at One McDonald's Plaza, Oak Brook, Illinois 60523-1900, believes that it will be damaged by registration of the marks "McFIT" and "McFIT (& Design)" in International Classes 16, 35, 38, 41 and 44 as shown in Application Serial Nos. 79/111,190, 79/129,412 and 79/129,414 (collectively, the "McFIT Marks"), filed by Applicant, McFit GmbH, a company organized under the laws of the Germany and having a place of business at Tannenberg 4, 96132 Schlusselfeld, Germany and hereby opposes the same and requests that registrations to Applicant be refused.

As grounds for its consolidated opposition, Opposer alleges that:

1. Applicant seeks to register the McFIT Marks for “printed matter, namely, books, booklets, flyers, magazines, journals, training and nutrition plans all in the field of physical training, mental balance, wellbeing, nutrition, diet counseling and fitness” in International Class 16, “advertising; business administration; business management; arranging of contracts of buying and selling of films, video and sound recordings for third parties; model agency services, namely, placement of models for advertising or sales promotion” in International Class 35, “broadcasting of films, audio, sound and video recordings; video transmission and broadcasting services via the Internet, local area network (LAN), satellites, optical communications, or other communications networks via streaming technology and delayed playback, featuring sporting, cultural and social events” in International Class 38, “providing sports facilities; sports studios, namely, providing group exercise instruction, personal training instruction, equipment and facilities, exercise classes, body sculpting classes, group fitness classes and fitness and exercise facilities; sports camps; rental of sports equipment except vehicles; organization of sporting competitions; entertainment services in the nature of cultural, musical and sporting events, namely, music festivals, concerts, live theatrical productions, group exercise activities, group runs, bicycle competitions, outdoor gymnastic classes, soccer competitions, baseball competitions, basketball competitions; arranging and conducting of seminars and workshops for educational purposes in the field of physical fitness, training, nutrition, health, wellness, mental wellbeing, music, languages and popular culture and distribution of training material in connection therewith; entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; film productions; film rental; rental of video and sound recordings; instruction in the fields of gymnastics; music composition

services, namely, composition of music for others” in International Class 41, and “solarium services; health club services, namely, providing instruction and equipment in the field of physical exercise; health training, namely, health counseling, providing health information” in International Class 44. The applications are based upon foreign trademark registrations and filed under §66(a).

I. OPPOSER’S USE OF ITS “MC” FAMILY OF MARKS

2. Since 1955, Opposer has continuously used the name McDONALD’S as a trademark and service mark in its business of developing, operating, franchising, and servicing an extensive system of restaurants that prepare, package, and sell a limited menu of high quality, quickly-prepared, modestly-priced foods. In addition, Opposer has widely used the “Mc” formative alone and together with other words throughout the United States and the world as trademarks and service marks for, and in advertising and promotion of, a wide variety of food products and restaurant services, including, but not limited to: salads, breakfast foods, specialty sandwiches, dessert products, chicken sandwiches, poultry products and beverages. Opposer has also used its “Mc” formative marks on a wide variety of goods that are not related to food products or restaurant services, including, but not limited to: chemical preparations; computer services; men’s, women’s and children’s clothing; barbershop services; mail order services; charitable services; recycling services; travel services; and concentrated cleaners.

3. Opposer has carried on this business throughout the United States and the world. Opposer and its subsidiaries now operate or license thousands of restaurants throughout the world, including over 14,000 restaurants in the United States.

4. Beginning with its world-famous “McDONALD’S” trademark, Opposer has used or licensed the use of numerous trademarks and service marks in connection with a wide variety of goods and services over the past 50 years. In connection with this business, Opposer has built an extensive family of “Mc” formative trademarks formed by the distinctive “Mc” prefix with various generic and descriptive terms.

5. In addition, Opposer has used various service marks over the last 25 years in connection with a host of educational programs and fundraising initiatives directed to the health and welfare of children and their families, which are directly related to the type of services for which Applicant seeks to register the McFIT Marks. In particular, McDonald’s has actively been involved with hosting and promoting health and fitness programs in elementary and secondary schools throughout the United States. For example, Opposer has offered its “PASSPORT TO PLAY” program, which has educated students on the topics of health, nutrition, fitness, well being and physical activity at schools across the United States. In fact, over seven million students in the United States have participated in the PASSPORT TO PLAY program. Opposer has also offered a “CHAMPIONS OF PLAY” program to encourage a balanced approach to nutrition and activity. Opposer is also the owner of the mark “GET MOVING WITH RONALD McDONALD,” which is registered for entertainment services, namely, performances by an individual in a clown costume and has been used in connection with children’s education programs focused on nutrition and exercise. Opposer, together with DreamWorks Studio, used the animated character, Shrek, to promote physical activity through its “Shrek’s Treketh to Adventure” games on its website that required both online and offline play to earn points and progress in the games. Opposer has further provided children’s playground facilities for recreation activities under the mark R GYM. Opposer, through the McDonald’s Foundation, has

also recently entered into a partnership with KaBOOM!, a national non-profit that envisions providing playgrounds within walking distance of every child in America. Together, Opposer and KaBOOM! have built playgrounds for children in cities across the nation, including Chicago, Baltimore, San Antonio, El Paso and Joplin.

6. Opposer also uses its various marks in connection with a variety of adult-focused health initiatives sponsored by Opposer. For example, Opposer sponsors the McDonald's Cycle Center to encourage biking as a means of staying healthy and fit, and weekly yoga and Pilates classes, both at the Millennium Park in Chicago, Illinois. Opposer also has promoted the "YOURSELF!FITNESS" program, which offered interactive 15-minute fitness DVDs on yoga, core, cardio and strength training as well as videogames directed to fitness for its customers. Furthermore, Opposer provided its "GO ACTIVE" program, which focused on the development and dissemination of educational materials of others in the field of health, fitness and active lifestyles. More specifically, the "GO ACTIVE! America Challenge" offered Opposer's consumers advice from world-class consultants on lifestyle and fitness. For example, for several years, beginning in 2003, Opposer offered consumers educational information on health, nutrition and fitness from the renowned personal trainer Bob Greene. Opposer has further promoted and encouraged fitness through its Balanced Active Lifestyles program, including promoting walking by offering Stepometers™ in Happy Meals.

7. To further encourage health and fitness amongst consumers, Opposer sponsors different athletic organizations and events, including, but not limited to: "MCDONALD'S ALL AMERICAN" high school basketball and soccer exhibitions and games, the Olympics, and FIFA World Cup™. In fact, Opposer became an Official Sponsor of the Olympic Games in 1976, and

has been a committed sponsor ever since to reinforce its commitment to the importance of sports and physical activity in connection with maintaining a balanced and healthy lifestyle. In connection with its sponsorship of the London 2012 Olympic Games, for example, and as part of its “CHAMPIONS OF PLAY” program, Opposer provided children from around the world the opportunity to attend the Games and play with athletes at the venues where the Olympians competed.

8. Opposer has used or is likely to expand the use of its “Mc” formative marks to include the same services or type of services for which the McFIT Marks are intended to be used by Applicant.

9. Opposer’s extensive nationwide advertising and promotion of its various goods and services under its family of “Mc” formative marks features the use of television and print advertising, radio, newspaper and magazine advertising, outdoor billboard and signage, Internet advertising, mobile advertising and direct mail, which are directed to and reach the public in both local and nationwide markets. In addition, Opposer uses the “Mc” formative family of marks on food product packaging and point-of-purchase advertising, and has used the “Mc” formative family of marks for a wide variety of other goods and services.

10. Opposer also owns a federal registration for “Mc,” Registration No. 1,947,099, issued on January 9, 1996, for restaurant services. The following is a partial list of federal registrations owned by McDonald’s:

<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
1. McDONALD’S	743,572	01/08/1963	Restaurant services.
2. McCAFE	2,482,828	08/28/2001	Restaurant services.

<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
3. McCAFE	3,201,441	01/23/2007	Beverages made of coffee beans, hot chocolate, pastries, muffins, cakes, cookies, biscuits and sandwiches.
4. McDONALDLAND	939,100	07/25/1972	Restaurant services.
5. McDOUBLE	1,266,500	02/07/1984	A sandwich for consumption on or off premises.
6. McRIB	1,315,979	01/22/1985	A sandwich for consumption on or off premises.
7. McMUFFIN	1,485,633	04/19/1988	Restaurant services.
8. McNUGGETS	1,450,104	07/28/1987	Restaurant services.
9. Mc	1,947,099	01/09/1996	Restaurant services.
10. McDIRECT SHARES	2,056,279	09/28/1995	Financial services, namely providing a direct company stock purchase plan.
11. McTEACHER'S NIGHT	2,684,782	02/04/2003	Charitable fundraising.
12. McGRIDDLES	3,151,707	10/03/2006	Hot cakes.
13. McWORLD	3,696,916	10/13/2009	Entertainment services, namely providing a website for interactive online games for children.
14. McBITES	4,129,420	04/17/2012	Meat, pork, processed fish and poultry.
15. McPOOL	1,592,450	04/17/1990	Recreational services in the nature of providing swimming facilities.
16. GET MOVING WITH RONALD McDONALD	2,999,077	06/20/2005	Entertainment services, namely, performances by an individual in a clown costume.
17. McDONALD'S ALL AMERICAN	3074,164	04/28/2006	Entertainment services namely conducting athletic events in the nature of basketball and soccer clinics and competitions.

	<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
18.	McDONALDS ALL AMERICAN GAME	1,287,324	05/01/1984	Entertainment Services Namely, Basketball Exhibitions.
19.	McDONALD'S ALL AMERICAN HIGH SCHOOL BASKETBALL TEAM	1,101,769	09/05/1978	Entertainment services in the form of a basketball team.

These registrations are valid, subsisting, and in full force and effect.

11. Each of the aforesaid registrations is at least *prima facie* evidence of the validity of each registration, of Opposer's ownership thereof, and of Opposer's exclusive right to use such registered marks on the goods or services set forth in the registration. In addition, McDonald's Corporation owns numerous other federal registrations of "Mc" formative marks for a variety of goods and services.

12. Through Opposer's extensive and continuous use of the name McDONALD'S and its "Mc" formative marks, the public has come to recognize marks combining the "Mc" prefix with a common word for a wide variety of goods and services as being uniquely associated with Opposer. Opposer has developed, at great effort and expense, exceedingly valuable goodwill with respect to the specific marks listed above, as well as for its entire "Mc" family of marks. Opposer's "Mc" family of marks is famous and was famous long prior to the date of filing of Applicant's subject application.

13. Both the Trademark Trial and Appeal Board and the Federal Circuit have long recognized the validity of McDonald's Corporation's rights to its famous "Mc" and "Mac" family of marks. McDonald's Corp. v. McClain, 37 U.S.P.Q. 2d 1274, 1276 (TTAB 1995) (stating "The family of [McDonald's] marks has been recognized by this Board and by the

courts”); McDonald’s Corp. v. McKinley, 13 U.S.P.Q. 2d 1895, 1899 (TTAB 1989) (stating “In view of opposer’s extensive evidence of use and promotion of marks having a “Mc” or “Mac” portion, there can be no doubt that opposer has established that its marks comprise a family”); McDonald’s Corp. v. McBagel’s, Inc., 649 F. Supp. 1268, 1272 (S.D.N.Y. 1986) (showing no hesitation in finding that McDonald’s “owns a ‘family of marks’ both registered and unregistered, whose common characteristic is the use of ‘Mc’ or ‘Mac’ as a formative”); J&J Snack Foods Corp. v. McDonald’s Corp., 932 F.2d 1460, 1463 (Fed. Cir. 1991) (recognizing “McDonald’s specific family of marks wherein the prefix “Mc” is used with generic food names to create fanciful words.”)

II. LIKELIHOOD OF CONFUSION & DILUTION

14. Despite Opposer’s long-standing prior rights in the name McDONALD’S and its “Mc” family of marks for restaurant services, food products, and a wide variety of other goods and services, Applicant filed applications to register the McFIT Marks in connection with “printed matter, namely, books, booklets, flyers, magazines, journals, training and nutrition plans all in the field of physical training, mental balance, wellbeing, nutrition, diet counseling and fitness” in International Class 16, “advertising; business administration; business management; arranging of contracts of buying and selling of films, video and sound recordings for third parties; model agency services, namely, placement of models for advertising or sales promotion” in International Class 35, “broadcasting of films, audio, sound and video recordings; video transmission and broadcasting services via the Internet, local area network (LAN), satellites, optical communications, or other communications networks via streaming technology and delayed playback, featuring sporting, cultural and social events” in International Class 38, “providing sports facilities; sports studios, namely, providing group exercise instruction,

personal training instruction, equipment and facilities, exercise classes, body sculpting classes, group fitness classes and fitness and exercise facilities; sports camps; rental of sports equipment except vehicles; organization of sporting competitions; entertainment services in the nature of cultural, musical and sporting events, namely, music festivals, concerts, live theatrical productions, group exercise activities, group runs, bicycle competitions, outdoor gymnastic classes, soccer competitions, baseball competitions, basketball competitions; arranging and conducting of seminars and workshops for educational purposes in the field of physical fitness, training, nutrition, health, wellness, mental wellbeing, music, languages and popular culture and distribution of training material in connection therewith; entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; film productions; film rental; rental of video and sound recordings; instruction in the fields of gymnastics; music composition services, namely, composition of music for others” in International Class 41, and “solarium services; health club services, namely, providing instruction and equipment in the field of physical exercise; health training, namely, health counseling, providing health information” in International Class 44. Moreover, in light of Opposer’s widespread advertising and promotion of its “Mc” formative marks, Applicant’s selection of marks, which incorporate the “Mc” prefix suggests that Applicant intends to trade off the goodwill and recognition associated with Opposer’s “Mc” family of marks.

15. The marks proposed for registration by Applicant have as their principal distinctive element the “Mc” prefix. Potential purchasers, upon seeing the dominant formative “Mc” in Applicant’s McFIT Marks are likely to mistakenly believe that such terms and the services offered thereunder originated with or are connected with, sponsored or associated by, or licensed or approved by Opposer. Thus, the registration and use by Applicant of the McFIT

Marks in connection with its services, for all channels of trade and all types of prospective purchasers, are likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1052(d).

16. Issuance of registrations to Applicant would diminish and dilute the distinctive quality of McDonald's rights in its famous "Mc" formative family of marks and could in the event of any mishaps involving, or poor quality of, the services offered by Applicant, tarnish such distinctiveness, in violation of 15 U.S.C. § 1125(c).

17. If registrations are issued to Applicant for the McFIT Marks, the confusion with Opposer's marks would result in damage and injury to Opposer and the public. Registration of these marks would give Applicant an unqualified right to wrongfully appropriate Opposer's valuable goodwill and reputation associated with Opposer's marks; to benefit from the likely confusion among purchasers led to believe that Applicant's services are related in some fashion to Opposer; dilute the distinctiveness of Opposer's marks and harm its goodwill and reputation associated with its marks by allowing any fault with or objection to Applicant's services to reflect upon Opposer; and to restrict the natural growth of Opposer's family of "Mc" formative marks.

III. LACK OF BONA FIDE INTENT TO USE

18. On or about December 23, 2011 and March 15, 2013, Applicant filed its applications for the McFIT Marks pursuant to Section 66(a) of the U.S. Trademark Act.

19. On information and belief, in connection with each of the aforementioned applications, Applicant submitted a declaration stating that it had a bona fide intent to use the McFIT Marks "in commerce that can be controlled by the United States Congress."

20. Despite having filed for registration of the McFIT Marks more than one year ago (and three years ago for Application Serial No. 79/111,190), Applicant has not taken any steps to use the McFIT Marks in connection with any of the goods or services covered by the subject applications.

21. Applicant has not determined any goods or services to be offered in connection with the McFIT Marks in the United States and lacks any documents relating to the same.

22. Applicant has not determined any date on which it intends to use the McFIT Marks in commerce and lacks any documents relating to the same.

23. Applicant has not determined any marketing plans for products or services to be sold or intended to be sold under the McFIT Marks within the United States and lacks any documents relating to the same.

24. Applicant has not determined the geographic areas or channels of trade within the United States in which Applicant's goods or services will be advertised and/or promoted under the McFIT Marks and lacks any documents relating to the same.

25. Applicant has not determined the manner or media in which any of Applicant's goods or services will be advertised and/or promoted under the McFIT Marks within the United States and lacks any documents relating to the same.

26. Applicant has not undertaken any advertising and/or promotion of products or services under the McFIT Marks in the United States, or even determined the market for its products or services.

27. Therefore, at the time of filing Application Serial Nos. 77/111,190, 79/129,412 and 79/129,414 for the McFIT Marks, Applicant did not have a bona fide intent to use the marks in commerce in connection with any of the goods or services covered by the applications.

WHEREFORE, McDonald's requests that this Consolidated Opposition be sustained and Application Serial Nos. 77/111,190, 79/129,412 and 79/129,414 be refused registration.

Respectfully submitted,

McDONALD'S CORPORATION

Date: January 21, 2015

By: /Lawrence E. James, Jr./

Robert E. Browne
John A. Cullis
Lawrence E. James, Jr.
REED SMITH LLP
10 South Wacker Drive, 40th Floor
Chicago, IL 60606-7507
(312) 207-1000 Telephone
(312) 207-6400 Facsimile

CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing **AMENDED NOTICE OF OPPOSITION** is being electronically transmitted via the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/> on the date noted below:

Date: January 21, 2015

By: /Lawrence E. James, Jr./
One of the Attorneys for Opposer,
McDonald’s Corporation

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **AMENDED NOTICE OF OPPOSITION** upon Applicant’s counsel:

Stacey C. Friends, Esq.
Ruberto, Israel & Weiner, PC
255 State St., 7th Floor
Boston, Massachusetts 02109

via First Class U.S. Mail on January 21, 2015.

/Lawrence E. James, Jr./
One of the Attorneys for Opposer,
McDonald’s Corporation